

**IN THE DRAWINGS:**

The attached sheet of drawings includes new Figure 5. Figure 5 was added to illustrate a bi-centered bit as discussed in the remarks section of the response.

**Attachment:        Replacement Sheet**

## REMARKS

This is intended as a full and complete response to the Final Office Action dated May 23, 2005, having a shortened statutory period for response set to expire on August 23, 2005. Claims 15-16 and 18-34 are pending in the application. Please reconsider the claims pending in the application for reasons discussed below.

### Election/Restrictions

Applicant acknowledges the withdrawal of claims 27 and 28 by the Examiner. Additionally, Applicant appreciates the examination of claim 34 along with the elected claim set.

### Claim Rejections Under 35 U.S.C. § 112

The Examiner rejected claims 31 and 32 under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement. According to the Examiner, the claims contain subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Applicant traverses the rejection. Applicant respectfully directs the Examiner to page 2, lines 29-30, and page 3, lines 1-4, where it states in part “ As used herein the term “rotary drill bit” means any bit that is rotated to create a borehole in subterranean earthen materials. Examples of such rotary drill bits include rolling cutter rock bits.....bi-centrix bits having sections with differing centers of rotation for drilling boreholes larger than the true diameter of the drill bit, and the like well known to those skilled in the art.” Therefore, Applicant respectfully requests the rejection of claims 31 and 32 be removed.

The Examiner rejected claims 20 and 21 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Applicant has cancelled claims 20 and 21, thereby obviating the rejection.

### Drawings

The Examiner objected to the drawings under 37 C.F.R. § 1.83(a) because a bi-centered bit with first and second sets of cutting elements as recited in claims 31-32

must be shown. In response, Applicant has added Figure 5 to illustrate a bi-centered bit with first and second sets of cutting elements. Applicant submits no new matter has been added. Therefore, Applicant respectfully requests the objection to the drawings be removed.

Claim Rejections Under 35 U.S.C. § 102(b)

The Examiner rejected claims 15, 22, and 29 as being anticipated by *Scott, et al.*, '571. In response, Applicant has amended claim 15 and Applicant traverses the rejection of claims 22 and 29.

As amended, claim 15 includes the limitation of a second set of the cutting elements adapted for drilling subterranean formation material, wherein the first and second sets are arranged in a common radial row and a common plane along a surface of the body. *Scott, et al.* does not disclose a rotary drill bit having a first and a second set of cutting elements arranged in a common radial row and a common plane along a surface of the body. For this reason, *Scott, et al.* can not be used to anticipate claim 15. Applicant, therefore, submits that claim 15 and the claims that depend therefrom are in condition for allowance and respectfully request withdrawal of the § 102(b) rejection.

Claims 22 and 29 include the limitation of a first set of cutting elements having a tip exposure substantially equal to a tip exposure of the second set of cutting elements. According to the Examiner, *Scott, et al.* in Figure 3 illustrates a first set of cutting elements (20a) having a tip exposure (i.e., circular cutting surface) that is substantially equal to a tip exposure (i.e., circular cutting surface) of a second set of cutting elements (20b). Applicant traverses the rejection because it can be clearly seen in Figure 3 of *Scott, et al.* that the tip exposure (i.e., exposure height) of the first set of cutting elements is not substantially equal to the tip exposure of the second set of cutting elements. In fact, *Scott, et al.* clearly states that the first set of cutting elements (20a) extend further outwardly than the second set of cutting elements (20b). (See *Scott, et al.*, col. 2, lines 60-65) For this reason, *Scott, et al.* can not be used to anticipate claims 22 and 29. Applicant, therefore, submits that claims 22 and 29 and the claims that depend therefrom are in condition for allowance and respectfully requests withdrawal of the § 102(b) rejection.

Claim Rejections Under 35 U.S.C. § 103(a)

The Examiner rejected claim 16 as being unpatentable over *Scott, et al.* in view of *Beaton* (U.S. 6,009,962). Claim 16 depends from claim 15. As set forth above, *Scott, et al.* fails to teach or suggest all the limitations in claim 15. Similarly, *Beaton* fails to teach or suggest all the limitations of claim 15. For this reason, neither *Scott, et al.* and/nor *Beaton* can be used to render claim 16 obvious. Applicant, therefore, submits that claim 16 is in condition for allowance and respectfully requests withdrawal of the § 103(a) rejection.

Allowable Subject Matter

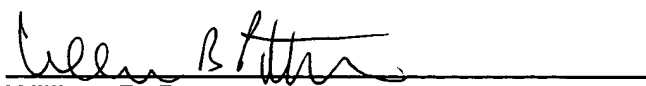
The Examiner objected to claims 25 and 26 as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. In response, Applicant has rewritten claims 25 and 26 as new claims 35 and 36. Applicant respectfully requests new claims 35 and 36 be allowed.

Conclusion

In conclusion, the references cited by the Examiner, alone or in combination, do not teach, show, or suggest the invention as claimed.

Having addressed all issues set out in the Final Office Action, Applicant respectfully submits that the claims are in condition for allowance and respectfully request that the claims be allowed.

Respectfully submitted,



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